REMARKS/ARGUMENTS

Claims 1, 3-17, 19-25, 27-31, and 33-37 are pending in the present application. In the Office Action mailed December 22, 2004, the Examiner rejected claims 1, 3-17, 19-24, 31, and 33-37 under 35 U.S.C. §103(a). As a result of this paper, claims 1, 17, 25, and 31 have been amended to recite that "the conflict between the selected application program and the software code is confirmed after the use of the software code has been detected." Support for this limitation is found throughout Applicants' specification including, for example, page 4, lines 25-27, page 6, lines 6-19, Figure 1, etc.

In light of these amendments and the following remarks, reconsideration and allowance of the pending claims is respectfully requested.

I. Rejection of Claims 1, 3-17, 19-24, 31, and 33-37 Under 35 U.S.C. §103(a)

The Examiner rejected claims 1, 3-17, 19-24, 31, and 33-37 under 35 U.S.C. §103(a) based on U.S. Patent No. 5,634,114 to Shipley (hereinafter "Shipley") in view of U.S. Patent No. 6,185,734 to Saboff *et al.* (hereinafter "Saboff") and in further view of U.S. Patent No. 5,590,056 to Barritz (hereinafter "Barritz"). *See e.g.*, Office Action, pp. 3-12. This rejection is respectfully traversed.

The M.P.E.P. states that

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.
>
> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan

> would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. §2142.

In the present case, the pending claims have been amended to recite that "the conflict between the selected application program and the software code is confirmed after the use of the software code has been detected." This claim element is not disclosed or suggested by any of the cited references. The only reference that arguable teaches anything related to a step of "confirming the conflict" is Shipley. *See* Office Action, p. 5. Thus, to the extent that Shipley may be interpreted as having a "confirming step," this confirming occurs before the use of the software code has been detected. Specifically, Shipley is designed such that any conflict between the application program and the software code that is in the DLL is "confirmed" prior to the software code being actually used. *See* Shipley Col. 7, lines 12-18 (prior to the software code being used, "the DLL discovers that the preferred version [of the application program] is not supported" at which point ... "the DLL returns to the application a 'not OK' or 'preferred version not supported' flag"). In fact, the purpose of Shipley's invention is to allow the application program to "confirm" this conflict to ensure that this conflicted software code in the DLL will never be used by the application. *See id.*; *see also* Shipley, Col. 7, lines 12-55. As such, Shipley will never have situation in which the conflict between the software code and the application program is confirmed prior to the time in which the use of the code is detected by the system.

Therefore, because Shipley, Saboff, and Barritz do not teach or disclose a system in which the confirming step occurs after the use of the software code has been detected, this combination of references cannot render the present claims *prima facie* obvious under 35 U.S.C. §103(a). Applicants respectfully request that this rejection be withdrawn.

II. Rejection of Claims 25 and 27-30 Under 35 U.S.C. §103(a)

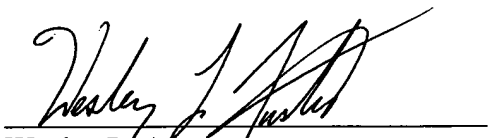
The Examiner rejected claims 25 and 27-30 under 35 U.S.C. §103(a) based on Shipley in view of Saboff and Barritz and in further view of U.S. Patent No. 5,960,204 to Yinger *et al.* (hereinafter "Yinger"). *See* Office Action, p. 12. This rejection is respectfully traversed.

As noted above, claims 25 and 27-30 all recite that "the conflict between the selected application program and the software code is confirmed after the use of the software code has been detected." Again, this claim element is not disclosed by Shipley, Saboff, or Barritz. Yinger also fails to teach a system or method in which the step or confirming the conflict between the application program and the software code occurs after the use of software code has been detected. Thus, because this element of the claims is not taught or suggested by any of the cited prior art, this combination of references does not render these claims *prima facie* obvious under 35 U.S.C. §103(a). Withdrawal of this rejection is respectfully requested.

III. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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